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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,355	11/07/2001	Mitchell D. Eggers	PW 083022 272515	3570

7590 12/08/2005

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EXAMINER	
ALEXANDER, LYLE	
ART UNIT	**PAPER NUMBER**
1743	

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/007,355	EGGERS, MITCHELL D.	
	Examiner	Art Unit	
	Lyle A. Alexander	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40 and 58-69* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40 and 58-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-40 and 58-69 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33, 58-62 and 94-101 of copending Application No. 10/005,529, claims 1-64 and 86-114 of copending Application No. 10/150,771 and claims 1-30 of copending Application No. 10/150,770 . Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to a sample carrier comprising a structural array having a plurality of node, optically labeled identification means and means to control/locate each sample.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-40 and 58-69 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Milosavljevic et al.

See the appropriate paragraph of the 8/27/04 Office action.

The 10/6/05 amendments add the limitations that each sample node is "discrete". The Office maintains the cited prior art teaches sample placement nodes that do not mix with other applied samples and meet the claimed "discrete" limitation.

Claims 1-14,20-35, 58-66 and 69 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hogan (WO 01/31317 cited by Applicant).

See the appropriate paragraph of the 8/27/04 Office action.

The 10/6/05 amendments add the limitations that each sample node is "discrete". The Office maintains the cited prior art teaches sample placement nodes that do not mix with other applied samples and meet the claimed "discrete" limitation.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 15-19,36-40 and 67-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan.

See the appropriate paragraph of the 8/27/04 Office action.

Response to Arguments

Applicant's arguments filed 10/33/05 have been fully considered but they are not persuasive.

Applicants' "node" has been clearly described in the specification and defines over the structures taught by the cited prior art. The Office has read the claimed node as any means to contain a sample. Applicants further state the cited prior art does not teach sample node that contain discrete samples. The Office maintains the cited art teaches discrete sample placed into unique and discrete containers for subsequent analysis which is indistinguishable from the instant claims. Applicants' argue the cited prior art fails to teach a node that is removabley attached to the structure of the array. The cited prior art teaches removing portions of the sample which has been read on the claimed "removably attached". Applicants' state the cited prior art fails to teach the claimed "attachment points". The Office maintains this term has been read properly as a point of attachment which is clearly taught by the cited prior art.

The 1.132 Declaration of 10/03/05 has been considered. Mr. Hogan, who is a co-inventor of the prior art, states the cited prior art does not teach the attachment points as presently claimed in claims 1,20 and 58. Mr. Hogan's statements are appreciated and held in high esteem. However, there is a lack of irrefutable evidence in the Declaration and it has been given its proper weight as the opinion of Mr. Hogan. It is not clear how Mr. Hogan has read/understood/interpreted the claimed "attachment points". The Office maintains attachment points are fairly taught by the cited prior art.

Applicants' remarks concerning the 35 USC 112 second paragraph rejections were convincing and these rejections have been vacated.

Applicants' traverse the 35 USC 102(e) rejections on the basis the cited references teach "punch cards" where the sample is punched out and removed from the

card. The Office maintains this has been properly read on the claimed "removably attached" and that the samples are placed in areas on the card where they do not mix with other samples (e.g. discrete locations on the card). Applicants' state the prior art by "punching out" severs or excises a bit of sample and substrate and the sample is not "discrete". The Office does not understand this logic. The "punched out" sample is a unified, distinct, individual sample and meets the instant claims. Applicants' also argue the "punched out" sample plugs cannot be read on the claimed removably attached. The Office does not agree and maintains the "punched out" plugs meet the "removably attached " limitation.

Applicants' state the cited prior art is silent to the claimed "plurality of sample structures". The Office does not agree maintaining the cited prior art teaches a plurality of sample application sites which have been read on this limitation.

Applicants' traverse the 35 USC 103 rejection on the basis the Office has failed to make a proper 35 USC 102 rejection. The Office maintains both rejections are proper.

Conclusion

This is a continuation of applicant's earlier Application No. 10/007,355. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lyle A Alexander
Primary Examiner
Art Unit 1743